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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,077	03/20/2004	David Scott Thompson		7903

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EXAMINER	
PITARO, RYAN F	

ART UNIT	PAPER NUMBER
2174	

DATE MAILED: 02/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/805,077	THOMPSON, DAVID SCOTT	
	Examiner	Art Unit	
	Ryan F. Pitaro	2174	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 have been examined.

Response to Amendment

2. This action is in response to Amendment A filed November 18, 2005. Claims 1-19 have been amended. This Action is Final.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1,2,4,6,9,12,15 are rejected under 35 U.S.C. 102(b) as being anticipated by Carissimo ("Carissimo", US 2002/0105412).

As per independent claim 1, Carissimo teaches a graphical dedicated receiving unit comprising radio signal receiving circuitry ([0016] lines 1-18) and a graphical display ([0008] lines 1-14).

As per claim 2, which is dependent on claim 1, Carissimo teaches a unit in which the unit is a transceiver ([0016] lines 1-18; inherent since data can be uploaded or downloaded wirelessly).

As per claim 4, which is dependent on claim 1, Carissimo teaches a patron paging system including at least one graphical dedicated receiving unit ([0012] lines 1-11) and at least one base station ([0017] lines 1-7, Figure 1 item 20, transmitter).

As per claim 6, which is dependent on claim 4, Carissimo teaches a system, in which at least one graphical dedicated receiving unit is powered by at least one electrochemical cell ([0024] lines 1-4).

As per claim 9, which is dependent on claim 4, Carissimo teaches a system in which at least one graphical dedicated receiving unit has sufficient memory to hold more graphical information than is displayed at a given time ([0016] lines 1-18).

As per claim 12, Carissimo teaches a patron paging system comprising at least one graphical dedicated receiving unit ([0008] lines 1-14), that graphical dedicated receiving unit comprising radio signal receiving circuitry ([0016] lines 1-18) and a graphical display ([0008] lines 1-14), in which at least one marketing message is displayed on the graphical display of at least one graphical dedicated receiving unit ([0012] lines 4-6).

As per claim 15, which is dependent on claim 12, Carissimo teaches a system in which an establishment using the system is a restaurant ([0012] lines 1-2).

5. Claim 20 is rejected under 35 U.S.C. 102(b) as being anticipated by Harel et al ("Harel", US 6366195).

As per independent claim 20, Harel teaches a dedicated receiving unit in which said unit is capable of dynamically adjusting its transmission power, wherein, that dynamic adjustment of the transmission power is based, at least in part, on the strength of signals sent by the base station and received by the unit (Column 2 lines 38-49).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Borst ("Borst", The Shape of Content).

As per claim 3, which is dependent on claim 1, Carissimo fails to teach the graphical display has no less than 20 pixels in each of two dimensions. However, Borst teaches a graphical receiving unit having at least 20 pixels in each of two dimensions (Page 1 PDA with screen of 160x160). Therefore it would have been obvious to an artisan at the time of the invention to combine the teaching of Borst

with the teaching of Carissimo. Motivation to do so would have been to provide a compact yet readable screen size.

8. Claims 5,7,8,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Showghi et al ("Showghi", US 2003/0050854).

As per claim 5, which is dependent on claim 4, Carissimo teaches an identification number for all of the portable units, but fails to teach an electronic serial number. However, Showghi teaches a system in which at least one graphical dedicated receiving unit has an electronic serial number for unique identification which allows signals from the base station to be used selectively by less than all of the graphical dedicated receiving units ([0053] lines 7-11). Therefore it would have been obvious to an artisan at the time of the invention to combine the teaching of Showghi with the system of Carissimo. Motivation to do so would have been to provide unique identification so that signals do not get crossed and the wrong patron is notified, which can result in angry customers.

As per claim 7, which is dependent on claim 4, Carissimo-Showghi teaches a system in which at least one graphical dedicated receiving unit has means for the user to cause the graphical dedicated receiving unit to send a radio frequency signal and the base station is capable of receiving that signal (Showghi, Figure 5, [0078] lines 1-15).

As per claim 8, which is dependent on claim 7, Carissimo-Showghi teaches a system in which said means is a pressure-sensing switch (Showghi, Figure 5, keypad).

As per claim 10, which is dependent on claim 4, Carissimo-Showghi teaches a system in which at least one graphical dedicated receiving unit is capable of synthesizing the frequency at which it receives signals (Showghi, [0078] lines 1-15).

9. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Yoon ("Yoon", US 5,867,782).

As per claim 11, which is dependent on claim 4, Carissimo fails to teach visually displaying an out of range message. However, Yoon teaches visually displaying at least one preset message when the unit is out of range of the signal of the base ([0033] 1-13). Therefore it would have been obvious to an artisan at the time of the invention to combine the teaching of Yoon with the system of Carissimo. Motivation to do so would have been to discourage theft of the pagers.

10. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Sibbitt ("Sibbitt", US 5999088).

As per claim 13, which is dependent on claim 12, Carissimo fails to distinctly point out self-advertising on the paging unit. However, Sibbitt teaches a marketing message displayed on at least one graphical dedicated receiving unit promoting the establishment employing the system (Sibbitt, Column 2 lines 28-38). Therefore it would have been obvious to an artisan at the time of the invention to combine the advertising teaching of Sibbit with the system of Carissimo. Motivation to do so would have been to provide useful and entertaining information through the pager while not interrupting the notification functions required of a restaurant type pager system.

As per claim 14, which is dependent on claim 12, Carissimo-Sibbitt teaches a system in which at least one marketing message displayed on the graphical display of at least one graphical dedicated receiving unit promotes the establishment other than that employing the system (Sibbitt, Column 2 lines 28-38).

11. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Shmelzer ("Shmelzer", US 6975207).

As per claim 16, which is dependent on claim 12, Carissimo fails to teach compensating a conveyor. However, Shmelzer teaches a system in which the conveyor of the system is compensated, at least in part, by rights involving advertising using the system (Column 4 lines 51-61). Therefore it would have been obvious to an artisan at the time of the invention to combine the teaching of Shmelzer with the unit of Carissimo. Motivation to do so would have been to provide a service to the patrons, which benefits all parties for free.

12. Claims 17,18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Harel et al ("Harel", US 6366195).

As per claim 17, which is dependent on claim 2, Carissimo fails to teach a dynamic adjustment of transmission power. However, Harel teaches a unit which is capable of dynamically adjusting its transmission power (Column 2 lines 38-49). Therefore it would have been obvious to an artisan at the time of the invention to combine the teaching of Harel with the unit of Carissimo. Motivation to do so would have been to provide a way to eliminate interference among subscriber units that transmit to the same base station.

As per claim 18, which is dependent on claim 17, Carissimo-Harel teaches a unit in which the dynamic adjustment of the transmission power is based, at

least in part, on the strength of signals sent by the base station and received by the unit (Harel, Column 2 lines 38-49).

13. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carissimo ("Carissimo", US 2002/0105412) in view of Vasquez et al ("Vasquez", US 2004/0227617).

As per claim 19, which is dependent on claim 1, Carissimo fails to teach two distinguishable sounds. However, Vasquez teaches a unit which is capable of creating at least two readibly distinguishable sounds (Vasquez, Figure 3). Therefore it would have been obvious to an artisan at the time of the invention to combine the distinguishable sounds of Vasquez with the system of Carissimo. Motivation to do so would have been to audibly provide the messages to a user in order to grab the users' attention if the user is not focused on the pager.

Response to Arguments

Applicant's arguments filed 11/18/2005 have been fully considered but they are not persuasive.

Applicants argue that Carissimo US 2002-0105412 is not enabling and therefore should be withdrawn as a prior art, and site In re Hoeksema in support. However, In re Hoeksema concludes the an enabling invention's disclosure must

be such that a skilled artisan could take its teaching in **combination with his own knowledge of the particular art and be in possession of the invention** (emphasis added). Furthermore, the Examiner notes that it is the case of non-enablement if, in fact, the claims are not supported by the specification. This is clearly not the case with Carissimo. The 112 rejection given in the office Action dated June 5th 2002 was non enabling because the specification did not disclose the claim language; however the claim language is not relied upon and the Examiner recognizes the different devices. Therefore, Carissimo is not withdrawn as prior art.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, one skilled in the art would realize the importance of customer satisfaction and would be motivated to combine the references based on the advantages stated above.

Applicants argue that the limitations of claim 20 cannot be found in the prior art. The Examiner points to Column 3 lines 32-43 for clarification purposes.

Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Diem teaches a graphical paging unit.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan F. Pitaro whose telephone number is 571-272-4071. The examiner can normally be reached on 7:00am - 4:30pm M-Th, and alternating F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine Kincaid can be reached on 571-272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Patent Examiner

RFP

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